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| 09/715,439  | 11/16/2000  | Shelton Louie        | 1205-002/JRD              | 5706             |
| 21034   | 7590        | 11/06/2006           | EXAMINER<br>FRENEL, VANEL |                  |
| IPSOLON LLP<br>111 SW COLUMBIA<br>SUITE 710<br>PORTLAND, OR 97201 |             |                      | ART UNIT<br>3626          | PAPER NUMBER     |

DATE MAILED: 11/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/715,439

Applicant(s)

LOUIE ET AL.

Examiner

Vanel Frenel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6,9,10,13,15-23,26-28,30 and 44-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,9,10,13,15-23,26-28,30 and 44-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/21/06 has been entered.

#### **Notice to Applicant**

2. This communication is in response to the Amendment filed on 7/21/06. Claims 1, 3-4, 6, 9-10, 13, 16, 21, 26-27, 44 and 48-49 have been amended. Claims 7-8, 11-12, 14, 24-25, 29, 31-43, 52-61 have been cancelled. Claims 1-6, 9-10, 13, 15-23, 26-28, 30 and 44-51 are pending.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6, 9-10, 13, 15-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harvey (6,611,806) in view of Lasher et al (5,771,657).

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(A) As per claim 1, Harvey discloses a method for tracking prescription orders through a pharmacy having a plurality of physically spaced apart locations for filling the prescription order, the plurality of spaced apart locations positioned along a workflow stream leading to a storage area with an array of compartments for storing filled prescription orders therein, said method including the following steps:

receiving a prescription order at a first location upstream of the storage area

(See Harvey, Col.12, lines 25-36);

operably securing remote machine-readable tag to the prescription order upstream of said storage area, said tag having a unique identifier that is readable by a tag reader in proximity to the tag regardless of its orientation relative to the tag reader (See Harvey, Col.4, lines 16-56);

associating the unique identifier of the tag with customer information stored in a computer system in association with the prescription order (See Harvey, Col.4, lines 4-31).

Harvey does not explicitly disclose that the method having manually moving the prescription order to one of the compartments in the array of compartments as a filled prescription order compartment having a corresponding compartment tag reader that is in communication with the computer system and is operable to read the unique identifier of the tag on the filled prescription order regardless of the orientation of the tag; and

automatically recording at the computer system the compartment where the filled prescription order at said second location and updating the computer system to indicate that the prescription order is not at the second location.

However, these features are known in the art, as evidenced by Lasher. In particular, Lasher suggests that the method having manually moving the prescription order to one of the compartments in the array of compartments as a filled prescription order compartment having a corresponding compartment tag reader that is in communication with the computer system and is operable to read the unique identifier of the tag on the filled prescription order regardless of the orientation of the tag (See Lasher, Col.13, lines 19-47; Col.15, lines 1-15) and

automatically recording at the computer system the compartment where the filled prescription order at said second location and updating the computer system to indicate that the prescription order is not at the second location (See Lasher, Col.3, lines 60-67 to Col.4, line 31).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Lasher within the system of Harvey with the motivation of providing a computer system called a Pharmacy Automation Computer (PAC) controls print, apply, and load stations (PAL stations), which print prescription labels, apply the labels to prescription bottles and load the labeled prescription bottles onto carriers (See Lasher, Col.1, lines 56-67).

(B) As per claim 2, Lasher discloses the method for tracking prescription orders through a pharmacy of claim 1, further including the steps of:

displaying the location of the prescription order on a computer system display, thereby facilitating the easy location of said prescription order (See Lasher, Col.5, lines 1-20).

The motivation for combining the respective teachings of Harvey and Lasher are as discussed in the rejection of claim 1 above, and incorporated herein.

(C) As per claim 3, Lasher discloses the method for tracking prescription orders through a pharmacy further including the steps of:

manually moving the prescription order to a second location within the pharmacy upstream of the storage area, the second location having a second location tag reader in communication with the computer system (See Lasher, Col.3, lines 31-67);

automatically detecting the presence of the prescription order at the second location by reading the unique identifier of the remote tag with said second location tag reader regardless of the orientation of said tag (See Lasher, Col.5, lines 13-37); and,

automatically recording at the computer system the location of the prescription order at said second location (See Lasher, Col.15, lines 44-67).

The motivation for combining the respective teachings of Harvey and Lasher are as discussed in the rejection of claim 1 above, and incorporated herein.

(D) As per claim 4, Harvey discloses the method for tracking prescription orders through a pharmacy further including the steps of:

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automatically collecting timing information about the amount of time the prescription order remains at the second location (See Harvey, Col.3, lines 45-67);

storing said timing information into the computer system (See Harvey, Col.7, lines 52-67); and,

compiling workflow information based on the timing information (See Harvey, Col.10, lines 6-22).

(E) As per claim 5, Harvey discloses the method for tracking prescription orders through a pharmacy further including the step of:

associating the workflow information with a particular worker to evaluate worker efficiency (See Harvey, Col.12, lines 44-57).

(F) As per claim 6, Harvey discloses the method for tracking prescription order through a pharmacy wherein said pharmacy is a retail pharmacy (See Harvey, Col.4, lines 16-28).

(G) As per claim 9, Harvey discloses a prescription order tracking system for use in a retail pharmacy having a first station therein for filling the prescription orders that each have a separate machine, readable tag operably secured thereto, each separate machine-readable tag having a unique tag identifier that uniquely identifies the prescription order to which the machine-readable tag is operably secured, said first station positioned along a workflow stream leading to a storage structure with an

array of compartments for storing filled prescription orders therein, said tracking system  
(See Harvey, Col.5, lines 18-65) including:

a computer system having a display (See Harvey, Col.12, lines 15-43).

Harvey does not explicitly disclose that the prescription order having a first tag reader positioned near the first station and in communication with said computer system, said first station not being a storage structure with an array compartments, said first tag reader automatically reading said tag when it is in the vicinity of said first tag reader and sending the unique tag identifier signal to said computer system; and

plural compartment tag readers, each of which is associated with a corresponding compartment in the array of compartments and is in communication with said computer system, each compartment tag reader reading the tag operably secured to any filled prescription order placed in the corresponding compartment and sending the unique tag identifier signal of the tag to said computer system with a compartment location signal that uniquely identifies the compartment where the filled prescription order is placed;

wherein said computer system displays whether the prescription order is located at said first station or in a specified one of said plural compartment in said storage structure.

However, these features are known in the art, as evidenced by Lasher. In particular, Lasher suggests that the method having a first tag reader positioned near the first station and in communication with said computer system, said first station not being a storage structure with an array compartments, said first tag reader automatically



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reading said tag when it is in the vicinity of said first tag reader and sending the unique tag identifier signal to said computer system (See Lasher, Col.13, lines 50-67; Col.15, lines 44-64); and

plural compartment tag readers, each of which is associated with a corresponding compartment in the array of compartments and is in communication with said computer system, each compartment tag reader reading the tag operably secured to any filled prescription order placed in the corresponding compartment and sending the unique tag identifier signal of the tag to said computer system with a compartment location signal that uniquely identifies the compartment where the filled prescription order is placed (See Lasher, Col.13, lines 50-67; Col.15, lines 44-64);

wherein said computer system displays whether the prescription order is located at said first station or in a specified one of said plural compartment in said storage structure (See Lasher, Col.13, lines 50-67 to Col.14, line 6).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Lasher within the system of Harvey with the motivation of providing a computer system called a Pharmacy Automation Computer (PAC) controls print, apply, and load stations (PAL stations), which print prescription labels, apply the labels to prescription bottles and load the labeled prescription bottles onto carriers (See Lasher, Col.1, lines 56-67).

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(H) As per claim 10, Lasher discloses the prescription order tracking system wherein the compartment tag readers associated with corresponding apartments each include an antenna and the antennas of plural tag readers are activated and read by a tag activating circuit in a multiplexed manner (See Lasher Col.13-37).

The motivation for combining the respective teachings of Harvey and Lasher are as discussed in the rejection of claim 1 above, and incorporated herein.

(I) As per claim 13, Lasher discloses the prescription order tracking system wherein said tag reader circuit includes an electromagnetic field generator, and said tag is includes an electromagnetic antenna (See Lasher, Col.5, lines 40-67).

The motivation for combining the respective teachings of Harvey and Lasher are as discussed in the rejection of claim 1 above, and incorporated herein.

(J) As per claim 15, Lasher discloses the prescription order tracking system wherein said tag is detachably secured to said prescription order (See Lasher, Col.1, lines 57-67).

The motivation for combining the respective teachings of Harvey and Lasher are as discussed in the rejection of claim 1 above, and incorporated herein.

(K) As per claim 16, Lasher discloses the prescription order tracking system wherein said tag is fixedly secured to said prescription order (See Lasher, Col.1, lines 57-67).

The motivation for combining the respective teachings of Harvey and Lasher are as discussed in the rejection of claim 1 above, and incorporated herein.

(L) As per claim 17, Lasher discloses the prescription order tracking system wherein said tag is secured to a carrier for receiving the prescription order therein (See Lasher, Col.5, lines 13-20).

The motivation for combining the respective teachings of Harvey and Lasher are as discussed in the rejection of claim 1 above, and incorporated herein.

(M) As per claim 19, Harvey discloses the prescription order tracking system wherein said computer system monitors the time interval said tag remains at said first location and compiles workflow information based on said time interval (See Harvey, Col.10, lines 6-22).

(N) As per claim 20, Harvey discloses the prescription order tracking system wherein said computer system correlates said workflow information with a particular worker to compile efficiency information on that worker (See Harvey, Col.8, lines 27-42; Col.11, lines 4-26).

(O) As per claim 21, Harvey discloses the prescription order tracking system wherein said computer system monitors the amount of time said prescription order remains within a particular compartment and automatically signals when said time exceeds a

predetermined amount, thereby allowing a pharmacy worker to restock said prescription order (See Harvey, Col.8, lines 27-42).

(P) As per claim 22, Lasher discloses the prescription order tracking system wherein said tag reader is rigidly secured at said first station (See Lasher, Col.5, lines 13-67).

The motivation for combining the respective teachings of Harvey and Lasher are as discussed in the rejection of claim 1 above, and incorporated herein.

(Q) As per claim 23, Harvey discloses the prescription order tracking wherein said tag reader is hand-held (The Examiner interprets wireless connections, and all other types of data communication systems to a form of handheld See Harvey, Col.4, lines 1-3).

5 Claims 26-28, 30 and 44-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harvey (6,611,806) in view of Lasher et al (5,771,657) as applied to claims 1-6, 9-10, 13, 15-23 above and further in view of Garber et al (6,448,886).

(A) As per claim 26, Harvey and Lasher do not explicitly disclose that the prescription order tracking system wherein said first reader includes an antenna positioned near the first station and the prescription order tracking system further includes a switching device that provides at predetermined time intervals tag reading multiplexing between the antennas of the compartment tag readers and the antenna near the first station.

However, this feature is known in the art, as evidenced by Garber. In particular, Garber suggested that the prescription order tracking system wherein said first reader includes an antenna positioned near the first station and the prescription order tracking system further includes a switching device that provides at predetermined time intervals tag reading multiplexing between the antennas of the compartment tag readers and the antenna near the first station (See Garber, Col.7, lines 1-39; Col.9, lines 17-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Garber within the collective teachings of Harvey and Lasher with the motivation of providing devices and applications which may be used in connection with items that are associated with an RFID tag, and optionally a magnetic security element (See Garber, Col.3, lines 30-32).

(B) As per claim 27, Garber discloses the prescription order tracking system wherein: said first tag reader is able to automatically detect when said tag is moved away from being in close proximity to said first tag reader and to send a second signal to said computer system (See Garber, Col.5, lines 24-60).

The motivation for combining the respective teachings of Harvey and Lasher are as discussed in the rejection of claim 1 above, and incorporated herein.

(C) As per claim 28, Harvey discloses the prescription order tracking system wherein said computer system monitors the time between receiving said first signal and said

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second signal to determine worker performance at the first station (See Harvey, Col.8, lines 27-42; Col.11, lines 4-26).

(D) As per claim 30, Garber discloses the prescription order tracking system where said tag is a radio-frequency identification ("RFID") tag (See Garber, Col.8, lines 10-35).

The motivation for combining the respective teachings of Harvey and Lasher are as discussed in the rejection of claim 1 above, and incorporated herein.

(E) Claim 44 differs from claims 1 and 9 by reciting a method for ensuring that a pharmacy worker distributes the correct prescription order to a customer of the pharmacy, the pharmacy having a storage portion with an array of individually identified storage areas therein, each individually identified storage area having a unique visual identifier.

As per this limitation, it is noted that Harvey discloses said method comprising:

receiving a prescription order at a first location spaced apart from the storage area within the pharmacy (See Harvey, Col.8, lines 6-61);

operably securing a machine-readable tag to the prescription order, the machine-readable tag having a unique tag identifier readable when placed in proximity to each a tag reader regardless of orientation of the tag relative to the tag reader (See Harvey, Col.4, lines 16-56);

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associating the machine-readable tag with customer information associated with the prescription order in the computer system (See Lasher, Col.3, lines 60-67 );

filling the prescription order defining a filled prescription order (See Lasher, Col.31-59);

placing the filled prescription order and the machine-readable tag into one individually identified storage area of the plurality of individually identified storage areas without instructions from the computer system as to which individually identified storage area the filled prescription order and the remote machine-readable tag are to be placed thereby defining a pharmacy worker selected storage area (See Lasher Col.3, lines 31-67 to Col.4, line 4) ;

reading the unique tag identifier of the tag within the pharmacy worker selected storage area with a tag reader that is associated with the pharmacy worker selected storage area, but not with any other individually identified storage areas in the array (See Lasher, Col.4, lines 54-67 to Col5, line 37);

retrieving the customer information from the computer system to determine the storage area identifier associated with the pharmacy worker selected storage area in which the customer's filled prescription order is located (See Lasher, Col.5, lines 1-37); and,

retrieving the filled prescription order from the identified pharmacy worker selected storage area of the storage portion (See Lasher, Col.5, lines 1-37) and Garber discloses providing the unique tag identifier and the storage area identifier for the pharmacy worker selected storage area to the computer system (See Garber, Col.17,

lines 1-48); the computer system correlating the customer information, unique tag identifier, and storage area identifier (See Garber, Col.17, lines 1-48).

Thus, it is readily apparent that these systems utilize a method for ensuring that a pharmacy worker distributes the correct prescription order to a customer of the pharmacy, the pharmacy having a storage portion with an array of individually identified storage areas therein, each individually identified storage area having a unique visual identifier to perform their specified function.

The remainder of claim 44 is rejected for the same reasons given above for claim 1 and 9, and incorporated herein.

(F) As per claim 45, Graber discloses the method wherein said tag is a radio-frequency identification ("RFID") tag and said tag readers are RFID readers (See Garber, Col.5, lines 24-60).

The motivation for combining the respective teachings of Harvey and Lasher are as discussed in the rejection of claim 1 above, and incorporated herein.

(G) As per claim 46, Lasher discloses the method wherein said storage area identifier is not related to information contained within the customer information (See Lasher, Col.1, lines 11-26).

The motivation for combining the respective teachings of Harvey and Lasher are as discussed in the rejection of claim 1 above, and incorporated herein.



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(H) As per claim 47, Lasher discloses the method wherein said storage area identifier is numeric (See Lasher, Col.4, lines 54-67).

The motivation for combining the respective teachings of Harvey and Lasher are as discussed in the rejection of claim 1 above, and incorporated herein.

(I) As per claim 48, Harvey discloses the method further including: detecting the removal of the tag from the pharmacy worker selected storage area by the tag reader associated with the pharmacy worker selected storage area (See Harvey, Col.8, lines 6-42).

(J) As per claim 49, Harvey discloses the method further including:  
monitoring with the computer system the time the tag remains within the pharmacy worker selected storage area (See Harvey, Col.8, lines 6-42).

(K) As per claim 50, Harvey discloses the method, further including placing a second filled prescription order with a second unique remote tag operably secured thereto within the pharmacy worker selected storage area such that the filled prescription order and the second filled prescription order concurrently occupy the same pharmacy worker selected storage area, and wherein the computer system associates customer identifying information for the second filled prescription, the second prescription order and the storage identifier (See Harvey, Col.8, lines 19-61).

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(L) As per claim 51, Harvey discloses the method, wherein the computer system detects the removal of the prescription order from the pharmacy selected storage area during the retrieving the prescription order step, and detects the continued presence of the second prescription order within the pharmacy selected storage area during the retrieving the prescription order step (See Harvey, Col.8, lines 19-61).

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not the applied art teaches systems and methods for drug dispensing (6,564,121), method and apparatus for reforming grouped items and customer specific packaging line (6,522,945).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 571-272-6769. The examiner can normally be reached on 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

V.F  
V.F

October 28, 2006

*Andrew Joseph Rudy*  
Primary Examiner, AU 3627